

### Remarks

The drawings, specification, and claims 1-28, 30 and 31 have been amended and new claims 32-37 have been added. Review and reconsideration in light of the amendments and the remarks below are requested.

The drawings have been amended to include the anti-static coating claimed in claim 16. The specification has been amended to accommodate this amendment to the drawings.

The Office action indicates that the drawings should be amended to include the binding means of claim 8. However, it is noted that the drawings already show an adhesive 20 which is a binding means of claim 8. For example, claim 8 specifies that the binding means generally closely conforms to the shape of each sheet and does not protrude significantly outwardly from each sheet. This language of claim 8 corresponds to the text at page 4, lines 16-19 of the application which describes the adhesive 20 as a binding means, which is shown in originally-filed Fig. 3.

The Office action also indicates that drawings should be amended to include the backing panel of claims 14 and 21. However, it is noted that the backing panel 18 is in fact disclosed in each of Figs. 1-3 and is discussed in the specification.

The specification is objected to on the basis that the specification fails to define the backing panel defined in claims 14 and 21, and that the specification fails to define what numeral 18 of the drawings represent. However, at page 2, lines 20 and 22 the reference number 18 is used to refer to the backing portion. In addition, by this Amendment the specification has been amended to more clearly indicate that the backing portion 18 corresponds to the claimed backing panel.

Claims 1-28 and 30 have been amended to address the claim objections thereto by changing "mousepad" to "mouse pad". Claim 11 has been amended to change "thoron" to "thereon" as requested in the Office action.

Claims 2, 9, 15, 17, 27, 30 and 31 are rejected as failing to comply with the enablement requirement. In particular, the Office action indicates that the application fails to define what materials are used to reduce a static electricity charge and to enable the surface resistivity of the sheets to be between 800 and 3000 ohms. However, as noted at Fig. 3, lines 8-12 of the application, the static electric charge of the sheets can be removed by induction, ionization,

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IN THE DRAWINGS:

Replace original Fig. 1 with attached replacement Fig. 1.

compressed air static eliminators, pulse DC static eliminators, anti-static bars, anti-static tinsel, passive static dischargers, or by using a static neutralizer. Thus the application clearly discloses how to create a reduced static electricity charge.

In addition, it is submitted that one of ordinary skill in the art would know or be able to easily identify anti-static coatings. For example, the cover sheet of various patents (U.S. Pat. Nos. 5,017,260; 4,154,344; 5,025,406; 4,966,280; 4,909,901; 6,638,630; 6,592,702; 6,649,271; 4,889,750; 5,614,318; 6,187,856; 6,066,442; and 6,585,843) are enclosed. Each of these patents discloses anti-static coatings or treatments, and many of them explicitly disclose their suitability for use with paper products. In addition, copies of several promotional materials and papers disclosing anti-static coating material, some of which are indicated to be useful with paper, are enclosed. It is noted that the invention is not directed to new anti-static coatings, but rather the use of conventional anti-static coatings in a new manner or to form a resultant new mouse pad.

As is well known, in order to determine whether a claim is enabled requires a determination of whether the disclosure contained sufficient information to enable one skilled in the art to make and use the claimed invention. MPEP §2164.01. In determining whether a claim is enabled, it should be determined whether one of ordinary skill in the art could make or use the invention from the disclosure *coupled with information known in the art* without undue experimentation. *Id.* In addition, MPEP §2164.01 indicates that a patent application need not teach, and even preferably omits, that which is well known in the art.

Thus it is submitted that the subject matter of claims 2, 9, 15, 17, 27, 30 and 31 is in fact enabled by the original application, and that the rejection to those claims be withdrawn.

Claims 1-8, 10-15, 17-26 and 28-31 are rejected as defining obvious subject matter over U.S. Pat. No. 5,876,010 to Murphy in view of U.S. Pat. No. 1,034,670 to Yawman. Accordingly, claim 1 has been amended to specify that the calendar portion has a time period of at least one week. In contrast, the calendar of the Yawman reference discloses a calendar portion having a time period of only one day. Independent claim 28 has been amended in a similar manner. Support for this amendment can be found at page 2, lines 10-12. Accordingly, it is submitted that claims 1 and 28 define over the cited references, even if those references are combined.

The calendar of claims 1 and 28, which specifies that the calendar portions have a time period of at least one week, provides significant advantages over the combination of the

Yawman and Murphy references. In particular, as noted above, the Yawman reference discloses a calendar with only daily pages and therefore presumably would be sold in 365 page increments. However, such a large stack of papers has a significant height (i.e., up to a few inches thick) and would be impractical for use as a mouse pad. In particular, utilizing a stack of sheets having this height would provide a bulky protruding stack of papers, and would also cause the wrist of a user to tilt upwardly at an awkward angle when placing a mouse on such a stack. Accordingly, the system defined in claims 1 and 28 provide significant advantages over the combined systems of the Murphy and Yawman references.

In addition, it is submitted that the Office action does not provide sufficient motivation for a combination of the Yawman and Murphy references. Initially, it is noted that one of ordinary skill in the art would not be motivated to combine references due to the very thick nature of the stack of sheets of the Yawman reference, as outlined above. In addition, the motivation provided in the Office action is essentially that providing the dates of the Yawman reference on the pad of the Murphy reference would make the pad "more useful." Under the reasoning advanced in the Office action, nearly any combination that would result in a device that is "more useful" would be obvious. However, in order to make a proper showing under obviousness "[T]here must be a showing of suggestion or motivation to modify the teaching of the reference . . . Whether the Board relies upon an express or implicit showing, it must provide *particular findings thereto* [citation omitted]. Broad conclusory statements standing alone are not 'evidence.'" *In re Kotzab*, 55 USPQ (BNA) 2d, 1313, 1317 (Fed. Cir. 2000) (emphasis added). In this case, the Office action has not provided "particular findings" but instead recites only a vague and general goal of increased usefulness.

The references only disclose a calendar on the one hand, a mouse pad on the other, and then it is concluded that it would have been obvious to combine the two. In formulating the rejection, the Office action does not cite to any reference which discloses or teaches the use of a calendar portion on a mouse pad. Instead, the Office action appears to use the teaching of the present invention as a template to construe the prior art. None of the references relied upon in the rejection disclose a need for a mouse pad having a calendar portion located thereon, or a calendar in a mouse pad format. In addition the relied-upon references do not recognize the advantages provided by the invention defined in the claims of this application. In contrast, the

current application discloses that each of the sheets 12 of the mouse pad calendar 10 are attached such that the uppermost sheet can be removed and discarded when the appropriate time period is past therefore exposing the next sheet 12b. In this manner, the invention provides both mouse pad support and varying sequential calendar portions (see page 3, lines 22-27).

Finally, it is noted that originally-filed claim 13 specifies that the calendar portion is a month. Although claim 13 is indicated to be rejected, no specific rejection of claim 13 or a discussion of the subject matter therein could be found in the Office action.

Thus, it is submitted that independent claims 1 and 28 define over the cited references and are therefore allowable.

Independent claim 15 specifies that each sheet has an anti-static electric property or a reduced static electricity charge. Claim 15 has also been amended to clarify that the reduced static electricity charge is reduced compared to paper which is not treated to reduce its static electricity charge. Claim 30 has been similarly amended.

Neither the Yawman nor the Murphy references disclose each sheet having an anti-static electric property or a reduced static electricity charge compared to paper which is not treated to reduce its static electricity charge. Thus it is submitted that claims 15 and 30 now define over the Yawman and Murphy references.

Claims 9, 16 and 27 have been rejected over the Murphy and Yawman references, and further in view of U.S. Pat. No. 5,997,995 to Scianna. However, the Scianna reference does not teach the use of using a dielectric material on the *upper surface* of the mouse pad; instead the Scianna reference teaches the use of a dielectric material on the *bottom non-slip support* of the mouse pad to prevent static.

The Office action refers to column 3, lines 1-6 of the Scianna reference which discloses that a dielectric material may be added to an ink to prevent static. However, the ink referred to at column 3, lines 1-6 is part of a thin film or coating 12 which forms an underlying non-slip material having a tacky texture on the bottom of the mouse pad (see column 2, lines 63-67). This non-slip material 12 is shown on the lower surface of the mouse pad in Figs. 1 and 2 of the Scianna reference, and the non-slip material contacts a desk or the like to prevent slippage of the mouse pad (see column 1, lines 14-19). Column 3, lines 18-20 and 39-40 further disclose the use of inks on the underside of the mouse pad to provide a non-slip surface.

In contrast, claims 9, 16 and 17 refers to an anti-static coating, or resistivity, or static electricity of each sheet. In contrast, if the teachings of the Scianna reference were to be applied to the combined device of the Murphy and Yawman references, the resultant structure would be a mouse pad with an anti-static coating on the base of the mouse pad, and not the individual sheets. Thus it is submitted that the Scianna reference is not relevant to the claims at issue.

New claims 34 and 36 depend from claims 1 and 15, respectively, and specify that the mouse pad calendar includes a backing portion having a non-skid surface to further distinguish over the cited references.

Claim 16 is also rejected as defining obvious subject matter over the Murphy and Yawman references, and further in view of U.S. Pat. No. 5,217,781 to Kuipers. The Kuipers reference discloses a standard mouse pad (i.e. a block of material not having tear-off sheets) wherein the top layer is a non-static polyvinylchloride material having a thickness in the range of 0.20 mm to 0.80 mm. However, this top upper layer of PVC is quite rigid and thick, and therefore would not be able to be practically used on the paper sheets of the Murphy and/or Yawman references.

In addition, the main thrust of the Murphy reference (the primary reference) is to provide micro-dome bumps having a height of between 0.005" and 0.100" inches. These bumps are made by thermographically printing on the paper surface and to provide a frictional surface for a mouse roller ball. However, if the PVC layer of the Kuipers reference were to be used on the sheets of the Murphy reference, it would be difficult to thermographically print on PVC such that the thermographically printed bumps adhere to the underlying PVC. On the other hand, if the PVC surface of the Kuipers reference were to be applied on top of the thermographically printed bumps of the Murphy reference, the PVC coating would smooth out all of the bumps and defeat the very purpose and teachings of the Murphy reference. Thus it is submitted that the Murphy, Yawman and Kuipers references cannot be combined in the manner proposed in the Office action.

Thus, in sum, it is submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

An information disclosure statement citing the patents and papers recited above with regards to the enable issue accompanies this Amendment.

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The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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